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APPLICATION NUMBER	FILED DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/898,853	07/25/97	YAMAGISHI	H 045980

QM11/0223  
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EXAMINER

MARLO G. ART UNIT

PAPER NUMBER

10

3711

DATE MAILED: 02/23/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on Jan. 4, 1999.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire —3— month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-12 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on Jan. 4, 1999 is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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The proposed drawing amendments filed Oct. 28, 1998 are not approved, but only because they are incomplete by failing to illustrate every critical feature claimed. For example, in claim 5, the surrounding layer hardness of D45 is not indicated in said proposed drawing amendment.

Claims 1-12 are rejected under 35 U.S.C. 102(a) or © as being anticipated by Higuchi et al (5,702,311).

The reference describes a golf ball including four components, having the following parameters:

core element 1- (a) hardness is 3.0-6.0mm

under a load of 100kg.

(b) diameter 25-35mm.

© material is polybutadiene.

core element 2- (a) hardness is 55-75 D

(b) thickness is 2.5mm., in example 5.

core element 2b- (a) hardness is 30-55 D

(b) hardness is 2.0mm, in example 5.

core element 3- (a) hardness is 50-70 D

(b) thickness is 2.0mm, in example 5.

Expressed in term of distortion, the overall hardness of said four components is 2.5 to 4.0mm, which means the ball is harder than the core element 1, which itself has a hardness of 3.0

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to 6.0mm. With the reference disclosure thus summarized, the claims clearly <sup>α</sup>red on the reference, except for claim 9 which recites an inner core element, (such as the reference element 1) which is harder than a surrounding layer, such as the core element 2a, of the reference. Regarding which claim 9, the examiner remains of the opinion that the reference core element 1 inherently is softer than the surrounding core element 2a, as in effect is recited in applicants' claim 9, last two lines. Also, the reference element 2b inherently is as much a cover element as is applicants' layer 15, as is evident simply from a comparison of the drawings.

Applicant's arguments filed Jan. 4, 1999 and Oct. 28, 1998 have been fully considered but they are not persuasive. Since the remarks filed Jan. 4, 1999 and Oct. 28 1998 do not compare the specific parameters recited in applicants' claims with those disclosed by the reference, such remarks are not persuasive. It is noted in the remarks filed Oct. 28, 1998 that applicants appear to consider only the claims of the reference, rather than the entire disclosure of the reference, which includes example 5, obviously. The examiner fails to see how Higuchi et al can be overcome by applicants foreign priority document which is later than the reference foreign priority date.

If the prosecution of this case is continued, applicants are required to rewrite all the claims so that they are all at one location in the file.

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George J. Marlo whose telephone number is (703) 308-2094. The examiner can normally be reached on Mon.-Thurs. from 7:30 a.m. to 7:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette Chapman, can be reached on (703) 308-2217. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3579.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Marlo/DMM

February 17, 1999

*George J. Marlo*  
GEORGE J. MARLO  
PRIMARY EXAMINER  
ART UNIT 3711  
3711